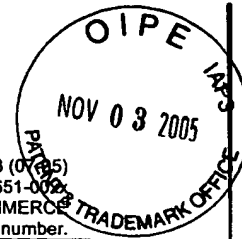


Doc Code: AP.PRE.REQ

PTO/SB/33 (07/95)

Approved for use through xx/xx/200x. OMB 0651-0002  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.



## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.0980-00000

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed  
name \_\_\_\_\_

Application Number

10/024,496

Filed

December 21, 2001

First Named Inventor

Gilles Rubinstenn

Art Unit

3639

Examiner

Igor N. BORISSOV

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).  
Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

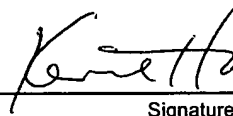
☐

attorney or agent of record.  
Registration number \_\_\_\_\_

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 51,808



Signature

Kenie Ho

Typed or printed name

(202) 408-4287

Telephone number

11/3/05

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☒

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT  
Customer No. 22,852  
Attorney Docket No. 05725.0980-00

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Gilles RUBINSTENN et al.

Application No.: 10/024,496

Filed: December 21, 2001

For: BEAUTY ADVISORY SYSTEM  
AND METHOD

)  
)  
) Group Art Unit: 3639

) Examiner: Igor N. BORISSOV

)  
)  
) Confirmation No.: 4463

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**Mail Stop AF**

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, appeal fee payment, and completed form PTO/SB/33 filed concurrently herewith, Applicants respectfully request a pre-appeal brief review of this application.

**Claim Rejection Under § 101**

In the Final Office Action mailed August 3, 2005 ("*Final Office Action*"), the Examiner rejected claims 1-26 and 32-50 as directed to non-statutory subject matter under § 101. *Final Office Action* at 3-7. Applicants respectfully traverse the rejection because the Examiner is improperly applying a "technological arts" test to the claims. The Board of Patent Appeals and Interferences has determined that there is no judicially recognized separate "technological arts" test to determine eligible subject matter under § 101. *Ex Parte Lundgren* (Bd. Pat. App. & Int., No. 2003-2088,

Oct. 2005). Accordingly, for at least the above reasons and the reasons discussed at pages 18-22 of the Amendment filed on June 8, 2005 ("*Amendment*"), the rejection of claims 1-26 and 32-50 under § 101 should be withdrawn.

### **Claim Rejection Under § 112, ¶ 2**

In the *Final Office Action*, the Examiner rejected claims 27-30, 40, 42, and 45 as indefinite under § 112, ¶ 2. *Final Office Action* at 2. For claims 27-30, the Examiner asserts that the claims are allegedly confusing, because it is not clear whether the claims are directed to a system or to a computer-readable medium for storing instructions. *Id.* For claims 40, 42, and 45, the Examiner asserts that the term "at least in part" allegedly renders these claims indefinite. *Id.*

Applicants note, however, that claim 27 and its dependent claims 28 and 29 specifically recite that it is directed to a "system," which comprises, *inter alia*, memory for storing personal information and memory for storing a program. *Amendment* at 7. Similarly, claim 30 specifically recites that it is directed to a "system," which comprises, *inter alia*, memory including a program that obtains personal information about a subject and a processor that runs the program. *Id.* at 7, 8. Finally, breadth of a claim should not be equated with indefiniteness. *M.P.E.P.* § 2173.04 (8th Ed. May 2004). Claims 40, 42, and 45 are not indefinite merely because the breadth of the claims encompasses methods conducted "at least in part" in a network environment.

Accordingly, for at least the above reasons and the reasons discussed at pages 14-18 of the *Amendment*, the rejection of claims 27-30, 40, 42, and 45 under § 112, ¶ 2 should be withdrawn.

### **Claim Rejection Under § 102(a)**

In the *Final Office Action*, the Examiner rejected claims 25 and 26 under § 102(a) based on PCT International Publication No. WO 01/18674 ("*Maloney*"). *Final Office Action* at 7, 8; Interview Summary of Oct. 25, 2005 ("*Interview Summary*"). Applicants respectfully traverse the rejection because the cited reference is completely missing certain limitations recited in claim 25. For instance, *Maloney* completely fails to teach "accessing local information for the geographic area," as recited in claim 25 and required by its dependent claim 26. *Maloney* also completely fails to teach "generating at least one recommendation for use of at least one cosmetic product on the list, the at least one recommendation being a function of the personal information of the subject and the local information," as recited in claim 25 and required by its dependent claim 26.

Accordingly, for at least the above reasons and the reasons discussed at pages 22-24 of the *Amendment*, the rejection of claims 25 and 26 under § 102(a) should be withdrawn.

### **Rejection Under § 103(a): Claims 1-9, 11-13, 17, 18, 20-24, 27, 30-32, and 34-50**

In the *Final Office Action*, the Examiner rejected claims 1-9, 11-13, 17, 18, 20-24, 27, 30-32, and 34-50 under § 103(a) based on *Maloney* and U.S. Patent No. 5,796,932 ("*Fox*"). *Final Office Action* at 8-17; *Interview Summary*. Applicants respectfully traverse the rejection because *Maloney* and *Fox* are completely missing certain limitations recited in independent claims 1, 27, 30-32, 41, 43, and 49. Pages 24-31 of the *Amendment* discuss these deficiencies of *Maloney* and *Fox* with respect to independent claims 1, 27, 30-32, 41, 43, and 49 and their dependent claims 2-9, 11-13, 17, 18, 20-24, 34-40, 42, 44-48, and 50.

**Rejection Under § 103(a): Claim 10**

In the *Final Office Action*, the Examiner rejected claim 10 under § 103(a) based on *Maloney, Fox*, and U.S. Patent Application Publication No. 2002/0082869 ("*Anderson*"). *Final Office Action* at 17, 18. Applicants respectfully traverse the rejection because *Maloney, Fox*, and *Anderson* are completely missing certain limitations recited in base claim 1 of dependent claim 10, and because nothing in the record supports the Examiner's alleged motivation to combine the cited references. Pages 32-33 of the *Amendment* discuss these deficiencies of *Maloney, Fox*, and *Anderson* with respect to claim 10.

**Rejection Under § 103(a): Claim 19**

In the *Final Office Action*, the Examiner rejected claim 19 under § 103(a) based on *Maloney, Fox* and Official Notice. *Final Office Action* at 19. Applicants respectfully traverse the rejection because the Examiner has failed to provide any evidence to demonstrate that features of the claimed invention are well-known in the art and capable of instant and unquestionable demonstration of being well-known. Pages 33-36 of the *Amendment* discuss the deficiencies of the Official Notice rejection.

**Rejection Under § 103(a): Claims 14-16, 28, 29, and 33**

In the *Final Office Action*, the Examiner rejected claims 14-16, 28, 29, and 33 under 35 U.S.C. § 103(a) based on *Maloney, Fox*, and U.S. Patent Application Publication No. 2002/0059248 ("*Farchione*"). *Final Office Action* at 18, 19. Applicants respectfully traverse the rejection because each of claims 14-16, 28, 29, and 33

depends upon one of base claims 1, 27, and 32 and includes the limitations recited therein. As discussed above, *Maloney* and *Fox* fail to teach or suggest certain limitations recited in claims 1, 27, and 32. With respect to claims 1, 27, and 32, *Farchione* fails to cure these deficiencies of *Maloney* and *Fox*. *Farchione* merely discloses a method for selecting fashion information for an individual. *Farchione*, Abstract. The method is directed towards training sales agents in product knowledge and application, as well as providing an individual a personal analysis and review of the combinations of cosmetic colors and clothing colors that are most appropriate for the individual based on skin color, hair color, eye color, body shape and body proportion. *Id.* at 1, ¶ [0003]. This does not teach or suggest the claim limitations missing from *Maloney* and *Fox* as discussed on pages 24-31 of the *Amendment*.

Accordingly, for at least the above reasons, the rejection of claims 14-16, 28, 29, and 33 under § 103(a) should be withdrawn.

### **CONCLUSION**

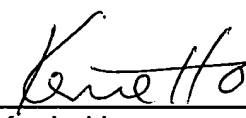
Applicants request withdrawal of all outstanding rejections and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this request and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: November 3, 2005

By:   
Kenie Ho  
Reg. No. 51,808